

Serial No. 09/439,194

REMARKS

According to the Office Action, "Applicant's arguments filed on the appeal brief of 7 June 2005 regarding claims 13, 16-23 have been fully considered but they are moot in view of the new grounds of rejection presented in this Office Action." It is respectfully submitted that the above statement mischaracterizes the reasons for reopening the prosecution and the Office Action. The same grounds of rejection under 35 USC 101 are presented in the Office Action. The Examiner is reminded that those rejections were subject to Applicant's appeal. The appeal was rendered moot by re-opening the prosecution; however, it appears that this Office Action fails to advance this case. The undersigned respectfully requests that the Examiner's supervisor, Mr. Safet Metjahic, review the history of this case and, in particular, this Office Action and contact the undersigned to discuss the examination of this case.

According to the Office Action, it is alleged that claims 13, 16, 17, and 19-21 are directed to non-statutory subject matter and thereby rejected under 35 USC 101. In response, the rejection is traversed for the following reasons. It is noted that the entire argument presented in the appeal brief filed on June 7, 2005, is repeated herein in full since the rejection is a virtual duplicate of the previously maintained rejection.

Some guidelines for patentability of signals are mentioned at MPEP 2106 IV B. (c). "However, a signal claim directed to a practical application of electromagnetic energy is statutory regardless of its transitory nature. See *O'Reilly*, 56 U.S. at 114-19; *In re Breslow*, 616 F.2d 516, 519-21, 205 USPQ 221, 225-26 (CCPA 1980)."

Applicant cited this section of the MPEP in the first amendment. The Examiner has failed to respond to this citation. Applicant respectfully submits that this is improper.

Claims 16-23 explicitly recite that the signal is electromagnetic and for use in a receiving device. Various signals specify how the signal is useful in the receiving device.

Serial No. 09/439,194

Claims 18 and 22 are clearest in this respect, because they recite that the signal enables listed operations in the receiving device. Applicant will not repeat these as they are listed above in the section summarizing the claims. Claims 18 and 22 further recite the practical results achieved by the signal in the receiving device, as explained above. In this way, these claims are very similar to those in the venerable O'Reilly v. Morse case cited by the MPEP in support of patentability of signals, where one of the claims stated

Eighth. I do not propose to limit myself to the specific machinery, or parts of machinery, described in the foregoing specifications and claims; the essence of my invention being the use of the motive power of the electric or galvanic current, which I call electro-magnetism, however developed, for making or printing intelligible characters, letters, or signs, at any distances, being a new application of that power, of which I claim to be the first inventor or discoverer.

Like that claim, claims 18 and 22, specifically set forth the result that the signals achieve in the receiving device and are therefore statutory.

Claims 13 and 16 further recite a practical use for the signal, namely the signal creates a plurality of identifiers in an ordered sequence & allows them to appear in a range represented by first and second subfields. The specification explains why this is useful and practical.

Original claim 13, does not specifically recite that the signals are electromagnetic; however, Applicant respectfully submits that other types of signal, such as ultrasound, have no legal distinction over electromagnetic signals. The claim does recite data signals. The claim therefore cannot be read on non-statutory subject matter such as text on paper, mere numbers, or natural phenomena.

Claims 19, 20, and 23 recite that the data items are relevant to television, which is also a field of practical application.

Serial No. 09/439,194

Applicant therefore respectfully submits that claims 16-23 clearly fall within the rubric of the cited MPEP guideline on patentability of signals.

Instead of applying the standard of patentability set forth in the MPEP as applicable to signals, the Examiner applies the standard applicable to data structures, namely that the material recited must be functional rather than merely descriptive. Applicant respectfully submits that the Examiner has applied the wrong standard. However, even if that standard does apply, the recitations of the claims are functional rather than descriptive and therefore satisfy the applied standard.

Claims 13, 16, and 17 all recite functional interrelationship between the parts of the signal, because the signals contain functional, technical self-description. This is different from just containing descriptive material as that terminology is used in section 2106 of the MPEP, which contains the guidelines for patentability of computer program like material. Descriptive material, as discussed in the guidelines, means material like text or pictures or music. Such material does not have function. When data contains a functional, technical self-description, by contrast, the data becomes more useful to a receiving device, since the receiving device can use the self-description in processing the data in the signal. The following table lists the types of functional, technical self-description to be found in these claims:

Claim	Function recited
13	a field indicating a number of data items
16	Analogous to 13
17	"wherein the first subfield represents a beginning of the range and the second subfield represents an end of the range"

Serial No. 09/439,194

Claim 21 recites that the subfields are modulo N numbers, where N is the maximum number of data items to be kept track of at a given time. This functional format allows for more efficient storage of data. This recitation is therefore statutory.

Applicant respectfully submits that the recitations of the claims satisfy 35 USC 101.

Further to Office Action, claims 13 and 18 are objected under 37 CFR 1.75 as allegedly being a substantial duplicate of claims 16 and 22, respectively. It is unclear as to why this objection is advanced now, at this stage of the prosecution: the claims have not been amended since September 17, 2004. Nevertheless, the objection is improper because it is conclusory and lacks any factual support referring to claim recitations. The objection is traversed.

The Examiner carries the burden of factually supporting the objections and explaining how claims with different limitations can be duplicates of each other. Until the Examiner provides the requested support for the objections, Applicant summarily traverses the rejections.

Still further to the Office Action, claims 13 and 16-23 are allegedly unpatentable over claims 7-10 of US Patent 6,057,886 and thereby rejected under the judicially created doctrine of obviousness-type double patenting. The rejections are improper and traversed as such.

The Examiner is invited to review section 804 (MPEP), a portion of which is reproduced below for her convenience (emphasis added):

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is - does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an "obviousness-type" nonstatutory double patenting rejection may be appropriate. Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent, or a non-commonly owned patent but subject to a joint research agreement as set forth in 35 U.S.C. 103(c)(2) and (3), when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1869 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000).

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379

Serial No. 09/439,194

F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obviousness-type double patenting analysis. These factual inquiries are summarized as follows:

(A) Determine the scope and content of a patent claim relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

(D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. >General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992).

Clearly, the Examiner failed to perform the required factual analysis, because she asserts in the Office Action "thus, claim 7 of the US Patent anticipates claims 13, 16, 17 of the instant application." The test is not anticipation as stated in section 804 of the MPEP. In addition, merely pointing out "transmitted data items of claim 7" are recited in Applicant's claims 13, 16 and 17 is conclusory and without any factual support.

Had the Examiner performed the required analysis, Applicant's claims 13 and 16-23 would be found unobvious over claims 7-10 of the '886 patent. Applicant's claims recite

Serial No. 09/439,194

limitations that were completely ignored by the Examiner and are not found in claims 7-10 of the '886 patent. As discussed above, the case law prohibits the use of patent disclosure as prior art. It is submitted that Applicant's claims 13 and 16-23 are not obvious over claims 7-10 of the '886 patent until the Examiner provides a more detailed analysis rather than mere "transmitted data items".

With respect to the alleged optional limitations, Applicant is not aware of any case or statutory law that refers to limitations as optional. The Examiner is respectfully requested to cite authority to support such proposition. Similarly, Applicant is not aware of any case or statutory law that holds that the alleged negative limitations do not to carry any patentable weight. Once again, the Examiner is respectfully requested to cite authority to support such proposition.

An earnest effort has been made to be fully responsive to the Examiner's correspondence and advance the prosecution of this case. If there are any questions, the Examiner is respectfully requested to call the undersigned attorney at the number listed below.

Please charge any additional fees associated with this application to Deposit Account No. 14-1270.

Respectfully submitted,

By 

Larry Liberkich, Reg. No. 40,352

Senior IP Counsel

Philips Electronics N.A. Corporation

914-333-9602